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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,301	08/02/2000	Yasunari Kimura	JEL 31225	8435

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EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/631,301

Applicant(s)

KIMURA ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in response to the restriction election filed on 23 September 2004.
2. Claims 1-10 and 17-26 have been cancelled.
3. Claims 11-16 have been examined.
4. The rejections of claims 11-16 have been updated to reflect the amended limitations.

## **RESPONSE TO ARGUMENTS**

5. Applicant's arguments received on have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

With regard to the limitations of claim 1, Applicant argues that Foladare does not teach a mobile terminal. The Examiner respectfully disagrees and points to the abstract. With regard to the Applicant's assertions that there is no teaching of the use of a password, the Examiner points to the background of the specification wherein the Applicant shows that password usage is already known in the art.

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**Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al., (US 5,914,472) in view of Ratayczak et al., (US 6,259,909).

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 11 and 13:**

Foladare discloses:

- *receiving information of a user at a point of service (POS) terminal (see at least Col 4, L11-23);*

- *obtaining an identifier of a communication terminal of the user based on the received information, said identifier comprising a mobile terminal call number;*
- *establishing a communication link between a signal source and the communication terminal using the communication terminal identifier ;*
- *establishing authentication of said user when the signal received by said signal source matches the signal sent by said signal source;*

See at least Abstract; Col. 4, L11-27; L35-39; Fig 1: steps 110-112; Fig 2, steps 210-216, related descriptions; Col 4, L39 - Col 5, L8; Fig 1, steps 116, 120, related description; Col 3, lines 2-33.

Foladare does not explicitly recite *(d) communicating a signal through a path comprising one of (i) a path from the signal source to the communication terminal, from the communication terminal to the POS terminal, and from the POS terminal back to the signal source and (ii) a path from the signal source to the POS terminal, from the POS terminal to the communication terminal, and from the communication terminal back to the signal source.* However, Foladare discloses that the user may initiate a transaction at a merchant POS, the POS sends the request for authorization to the authentication system (Applicant's "signal source"), the system will contact the user's communication terminal, and the user's communication terminal will forward a response back to the system, for final authorization.

In addition, Ratayczak teaches that such an authentication system may use many permutations of the sequence of communications between a user, POS terminal, and authentication center. Fig 5 of Ratayczak, in particular shows how a user causes a POS terminal (C1) to send a request to a signal source (A) for authorization of a request. The signal source (A) then sends a query to the user's communication terminal (C2). The user communication terminal (C2) then forwards the appropriate response to the POS terminal (C1). The POS terminal (C1) then forwards the user response back to the signal source (A). When the signal source (A) determines that the response is correct (from checking the user's information in a database S), the transaction requested is authorized

(see Fig 5, associated description). Therefore, it would have been obvious to one ordinarily skilled in the art at the time the invention was made that features as described above from the cited references may be implemented, in order to provide a strong, secure authentication and transaction confirmation system, particularly when the embodiment includes a POS terminal. Such a method and system would allow users to prevent any fraudulent or unauthorized charges from being made against their account without their express approval.

**Claims 12 and 14:**

Foladare in view of Ratayczak disclose all the limitations of claims 11 and 13. Foladare further discloses *step (b) includes correlating the received member information with corresponding information stored in a database to obtain said identifier from the corresponding information* (see all citations already used above).

**Claim 15:**

Foladare in view of Ratayczak disclose all the limitations of claim 13. Foladare further discloses *the link establishment means establishes the communication link in response to a stimulus originated by the signal source* (see at least Col 5, L37 - C6, L3).

**Claim 16:**

Foladare in view of Ratayczak disclose all the limitations of claim 13. Foladare further discloses

- *the signal source generates the communicated signal* (Col 5; L37 - C6, L10);
  - *the authorization means authorizes the event if the received condition of the signal communicated through the circuit indicates a likelihood of matching the signal generated by the signal source* (same citation as above); and
-

- *the authorization means does not authorize the event if the received condition of the signal communicated through the circuit indicates a likelihood of not matching the signal generated by the signal source (same citation as above).*

Foladare does not specifically recite using an authentication system with two sets of user identifiers and passwords. However he does teach that the confirmation step whereby the user is contacted by the authentication system may comprise (1) many different communication methods (two-way pager, cellular phone, other personal communication devices) (see at least Col 4, L58 - C5, LB) and (2) many different user responses for approval and disapproval of a transaction (voice command, yes/no, keypad inputs - i.e. a code or password) (see at least Col 5, L2-8). It would have been obvious to one ordinarily skilled in the art at the time the invention was made that among those responses a second set of member identifier and password may be predetermined, for the user to communicate approval or disapproval to the authentication system. Such an embodiment of Foladore's invention would have made the process of responding faster and more reliable, both from the user's perspective and from the authentication system's.

In addition, the above obviousness and motivation analysis, Ratayczak is another prior art directed to a method and apparatus for authentication of a user wherein the use of two sets of identifiers and passwords, communicated through two independent and separate channels is clearly taught (see at least Abstract; Col 1, L45-55; Col 2, L4-13; C2, L28-34: "code words" in this context are synonymous with "passwords"; Figs 1-2, 7, associated description). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined the above features of Foladare and Ratayczak in an embodiment of an authentication system as recited in claim 1. Such a system would provide a strong, secure, reliable, yet convenient method for independently confirming the identity of a user and his/her access to remote assets or to secure the user's confirmation of transactions requested on his/her behalf.

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**Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
9. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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or faxed to:

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After Final communications labeled "Box AF"]

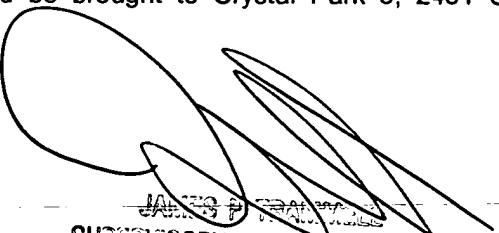
**(703) 308-1396** [Informal/Draft communications, labeled "PROPOSED"

or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JAR

29 October 2004



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNICAL FIELD: 3621